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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
ALVAREZ, RAQUEL	
ART UNIT	**PAPER NUMBER**
3688	

MAIL DATE	DELIVERY MODE
09/22/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/719,413	NELSON ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *22-29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 6/12/2008.

2. Applicant has elected without traverse, Group I, consisting of claims 1-21.

3. The listing of the claims must be changed to reflect the withdrawn claims. See 37 CFR 1.121.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Based on Supreme Court precedent [1] and recent Federal Circuit decisions, a 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. [2] If either of these requirements is met by the claim, the method is non a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter.

Independent claims 1 and 3 are rejected under 35 U.S.C. 101 as drawn to a non-statutory subject matter. The applicant is reciting only method steps such as "determining….playing…selecting", the applicant has not recited an apparatus or device to perform these limitations and without apparatus or device these limitations are just mental steps. Mentioning computer in the preamble is not enough, if the body of the claims each of the steps can be performed manually.

In claims 1 and 3 the steps are related to a mental process, which is not patentable. Indeed, it is not tied to another statutory class or does not change or switch statutory class (such as a particular apparatus or physical module or device) or does not transform the underlying subject matter (such as an article or materials) to a different state or thing. See MPEP §2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category.*

Examiner suggests applicant inserts a device in one or more steps of the body of the claims in order to overcome this rejection.

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[1] Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

[2] The supreme court recognized that this test is not necessary fixed or permanent and may evolve with technological advances. Gottschalk v. Benson, 409 U.S. 63,71 (1972)

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 2 recites the limitation "said recording" in line 1. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 21 recites the limitation "said downloaded" in line 1. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “can be” renders the claim indefinite because it

doesn't positevley recite the recited element. The term "can be" makes the claim limitations optional.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 3-4, 10-13, 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hasegawa (6,632,992 hereinafter Hasegawa).

With respect to claims 1, 12, Hasegawa teaches a method for playing back a media file (Abstract). Determining a designated type associated with said digital file (i.e. determining if the media should be provided at a discount or at a regular price based if advertisements are to be appended or not appended to the music data (see Figures 7 and 8); playing back said digital media file including required advertising in accordance with said determined type of media file (the user plays the music and the advertisements accordingly)(see Figure 9 and col. 11, lines 18-24).

With respect to claims 3-4, 13, Hasegawa teaches a method for playing back a digital file (Abstract). Defining a plurality of predetermined media types in accordance

with an advertising scheme (i.e. determining if an advertisement should be appended or not according to a variety of advertisement/discounted prices scheme)(see Figure 7 and 8); Valuing each of said plurality of predetermined media types in accordance with said advertising scheme (See figure 9 and col. 11, lines 18-24); selecting one of said plurality of media type (see figure 8); playing back said selected media type and invoking said associated advertising scheme (See Figure 11).

With respect to claims 10 and 19, Hasegawa further teaches that the media file is provided on a removable storage medium (i.e. external storage unit 17a may be a floppy disk, CDS or DVD)(see Figure 2).

With respect to claims 11 and 20, Hasegawa further teaches downloading said digital media file via a computer network (see Figure 1).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 2, 5-9, 14-18, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa.

Claims 2, 5-7, 14-16, further recite forcing the user to viewed said advertisement before a predetermined portion of said has viewed a predetermined portion of said digital media. Since in the system of Hasegawa the user gets a discounted price on the media file for viewing ads then it would have been obvious to make or force the user to watch the ads and not to let him or her fast forward or view a large amount of the media file without viewing the ads in order to avoid the user cheating by not viewing the ads required to get the free or discounted media. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included forcing the user to viewed said advertisement before a predetermined portion of said has viewed a predetermined portion of said digital media in order to obtain the above mentioned advantages.

With respect to claims 8 and 17, Hasegawa further teaches that the advertisement data can be still image data, moving image or both (col. 9, lines 4-6).

Claims 9 and 18 further recite updating the advertising data in accordance with a user profile. Official Notice is taken that it is old and well known to collect user's profile such as purchases data and the like in order to present the user with a personalized ad or coupon that the user will most likely redeem based on his prior purchasing habits. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included updating the advertising data in accordance with a user profile in order to achieve the above mentioned advantage.

Claim 21 further recites storing the digital file locally, updating and preparing it for retail. Storing files locally updating them and preparing them for distributions are old and well known to make the file accessible and versatile for sale. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included storing the digital file locally, updating and preparing it for retail in order to achieve the above mentioned advantages.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James w. Myhre can be reached on (571)272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
9/17/2008